

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/866,730 Confirmation No.: 7131
Applicant : David Allen Hays
Filed : May 30, 2001
Title : METHOD AND SYSTEM FOR PROVIDING AN ONLINE
COLLECTIONS SERVICES MARKETPLACE
TC/Art Unit : 3628
Examiner: : Elda G. Milef

Docket No. : 57792.000003
Customer No. : **21967**

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicant hereby requests a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicant believes that an appeal will succeed are set forth below. This application was filed May 30, 2001, with a priority claim to provisional application 60/207,951 filed May 31, 2000. In the Office Action mailed December 19, 2005 ("Office Action"), claims 1-8, 10-18 and 20 were rejected under 35 U.S.C. § 103(a) by U.S. Patent No. 6,233,566 to Levine ("Levine") in view of U.S. Patent No. 6,598,026 to Ojha ("Ojha"). Claims 9 and 19 were rejected over Levine, Ojha and further in view of U.S. Patent No. 6,012,046 to Lupien ("Lupien"). In response, Applicant submitted arguments against the rejections and further amended the claims to clarify the novel aspects of the embodiments of the present inventions in the Response filed March 20, 2006 ("Response"). The Examiner mailed a Final Office Action

on May 24, 2006 (“Final Office Action”) rejecting the amended claims 1-4, 7-8, 11-14, 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable by Levine. In addition, claims 5, 6, 15 and 16 are rejected over Levine in view of the Pfeifer article, claims 9 and 19 are rejected over Levine in view of Lupien and claims 10 and 20 are rejected over Levine in view of Ojha.

Each of the rejections fails to properly address each and every claim limitation and further fails to provide a proper statement of motivation. In sum, a *prima facie* case of obviousness has yet to be set forth for any of the office actions in this application, including the present Final Office Action. Accordingly, rather than proceeding with an expensive appeal, Applicant respectfully request that the Office, following consideration of the remarks below, issue a Panel Decision allowing the application based on existing claims and closing the prosecution record. If the Panel declines to issue such a finding, Applicant requests that the Office either issue a proper office action stating a thoughtful basis for rejection or allow this application to proceed to appeal.

On the merits, claims 1-4, 7-8, 11-14, 17 and 18 are currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Levine. This rejection is flawed for at least the following reasons. The claims recite “subscribing with an online collections services system wherein a Client inputs profile data and wherein the Client is in search of a Provider for collecting receivables on behalf of the Client *where the receivables are amounts owed to the Client as a result of extending credit to a third party.*” The Office Action recognizes that Levine discloses “a centralized exchange system for loans.” *See* page 3, Final Office Action. The system of Levin appears to be directed to buying and selling loans. *See* Levine, Abstract. Contrary to the Office Action, Levine does not disclose an online collections services marketplace for retaining professional services of collections agencies in an effort to collect the

delinquency. As such, Levin fails to even address the concept of “receivables,” as defined by the claims. In addition, the Office Action has failed to address this deficiency in the applied reference.

The claims further recite “enabling the Client to select one of a plurality of options *wherein the plurality of options comprises (1) a bidding process where the Client specifies a plurality of bidding participants to bid on the receivables and identifies a single Provider, (2) an optimization process where the Client specifies preference information and is presented with a single Provider determined to be capable of providing an optimal return for the receivables and (3) a manual process where the Client searches for a single Provider based on search criteria; selecting the single Provider identified by the selected option to collect the receivables.” The claims clearly recite a plurality of options as identified by (1) a bidding process, (2) an optimization process and (3) a manual process. The Office Action addresses each option in a cursory manner and merely concludes obviousness. *See* pages 4 and 5, Final Office Action. Further, the Office Action improperly relies on Levine’s alleged disclosure of a bidding feature to address both option (1) a bidding process and (2) an optimization process. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. Each claim limitation must have meaning and cannot be interpreted to be devoid of any meaning. The Examiner has the burden to show where in the reference each claim limitation is found. By using the same feature in Levine to address distinct claim features, the Examiner is collapsing several claim limitations into one and thereby effectively improperly eliminating claim elements. As a result, the Examiner has improperly eviscerated option (2), which is distinct from option (1) and option (3).*

In addition, for the (3) manual process option, the Office Action merely alleges that “it is obvious to manually perform tasks that are commonly done on a computer.” However, this conclusory statement does not address option (3) as recited by the claims. The overly broad application of the Levine reference suggested by the Office Action contradicts the claim language which defines at least three distinct options. Therefore, Levine clearly fails to “enable the Client to select one of a plurality of options where the plurality of options comprises (1) a bidding process .. (2) an optimization process ... and (3) a manual process,” as required by the claims.

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See In re Lee*, 277 F.3d 1338, 1343-46, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002); *In re Rouffett*, 149 F.3d 1350, 1355-59, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action’s justifications for modifying and combining the Levine reference have absolutely nothing to do with the admitted deficiencies of Levine. To properly modify Levine to correct for the admitted deficiencies, the Office Action has the burden

to show some motivation why providing those elements would have overcome some perceived problem with Levine. Any such motivation is completely lacking.

The mere fact that Levine can be somehow combined and modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. The Examiner has clearly failed to reach the initial burden. Therefore, the pending claims are patentable over the prior art and are believed to be in condition for allowance. Thus, an appeal on the current rejections will certainly succeed, but the time and expense in preparing an appeal brief on these issue should not be borne by Applicant when the grounds are so clearly improper.

Respectfully submitted,

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